

**REMARKS**

In the present Amendment, claim 1 has been amended to further recite that the resist composition includes a component (D1) or (D2), where component (D1) is an alkali-soluble resin having a phenol skeleton, and (D2) is a resin capable of increasing its solubility in an alkali developer by the action of an acid. This amendment is supported by the specification, for example, at page 116, last paragraph and page 141, 4<sup>th</sup> paragraph.

Claim 13 has been amended to recite that the alkali-soluble resin has a phenol skeleton. This amendment is supported by the specification, for example, at page 116, last paragraph.

Claims 3, 4, 7, 13-15 and 17-19 have been amended to improve their format. These amendments are not to be deemed to narrow the scope of the claims.

Claim 16 has been amended to be consistent with claim 13 from which it depends.

No new matter has been added and entry of the Amendment is respectfully requested. Upon entry of the Amendment, claims 1-21 will be all the claims pending in the application.

**I. Response to Rejection Under 35 U.S.C. § 102(b)**

In Paragraph No. 3 of the Action, claims 1-13 and 18-21 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kodama et al (EP 1179750).

Applicants respectfully submit that the amended claims are not anticipated by EP '750. As described above, Applicants have in the present Amendment amended claim 1 to further recite that the resist composition includes a component (D1) or (D2), where the component (D1) is an alkali-soluble resin having a phenol skeleton, and (D2) is a resin capable of increasing its solubility in an alkali developer by the action of an acid. Further, Applicants have amended

claim 13 to define resin (D1) as an alkali-soluble resin having a phenol skeleton. EP '750 does not disclose these features.

With respect to claims 5, 7 and 18, EP '750 does not disclose or suggest a compound containing  $\text{Ra-Rc-O}^-$  or  $\text{Ra-O}^-$  as recited in present claims 5 and 18, respectively, or a partial structure of formula (VIII) as recited in present claims 7 and 18. For these independent reasons, Applicants respectfully traverse the rejection of claims 5, 7 and 18.

With respect to claims 8-10, none of the acid-decomposable dissolution-inhibiting compounds disclosed on pages 81 and 82 of EP '750 and relied upon by the Examiner is a phenol derivative, contains a vinyl ether structure, or is a cyclic ether compound as recited in present claims 8-10. For these independent reasons, Applicants respectfully traverse the rejection of claims 8-10.

Further, claim 17 is not included in the rejection and claims 19 and 20 depend from claim 17. On this additional basis, Applicants respectfully traverse the rejection of claims 19 and 20.

In view of the foregoing, Applicants respectfully submit that the present claims are novel in view of EP '750 and that the rejection should be withdrawn.

## **II. Response to Rejection Under 35 U.S.C. § 103(a)**

In Paragraph No. 5 of the Action, claims 1-21 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kobayashi et al (6,136,500).

Applicants respectfully submit that the present claims are not obvious over Kobayashi et al. As described above, Applicants have in the present Amendment amended claim 1 to further recite that the resin composition includes a component (D1) or (D2), where the component (D1) is an alkali-soluble resin having phenol skeleton, and (D2) is a resin capable of increasing its

solubility in an alkali developer by the action of an acid. Applicants have also amended claim 13 to define resin (D1) as an alkali-soluble resin having a phenol skeleton. Kobayashi et al does not disclose or suggest these features. In addition, a compound corresponding to the compound (B) of the present invention was not used in any of the Examples in Kobayashi et al.

With respect to claims 8 and 9, Kobayashi et al does not disclose or suggest a cross-linking agent which is a phenol derivative containing from 1 to 10 benzene ring atomic groups per molecule and having at least one hydroxymethyl group and at least one alkoxymethyl group per molecule, or a cross-linking agent containing vinyl ether groups. For these additional reasons, Applicants respectfully traverse the rejection of claims 8 and 9.

With respect to claims 5, 7, 13, 14 and 17-21, Kobayashi et al. does not disclose or suggest a compound containing  $Ra-Rc-O^-$  or  $Ra-O^-$  as recited in the present claims 5, 14 and 18, respectively, or a partial structure of formula (VIII) as recited in the present claims 7, 13-14 and 17-21. For these additional reasons, Applicants respectfully traverse the rejection of claims 5, 7, 13, 14 and 17-21.

In view of the foregoing, Applicants respectfully submit that the present invention is patentable over Kobayashi et al and that the rejection should be withdrawn.

### **III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No.: 10/613,044

Attorney Docket Q76465

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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